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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/826,383

04/04/2001

Shigeyoshi Yoshida

0694-143

2904

7590

09/28/2005

BRADLEY N RUBEN

463 FIRST STREET

SUITE 5A

HOBOKEN, NJ 07030-1859

EXAMINER

NGUYEN, KHIEM D

ART UNIT

PAPER NUMBER

2823

DATE MAILED: 09/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

09/826,383

Applicant(s)

YOSHIDA ET AL.

Examiner

Khiem D. Nguyen

Art Unit

2823

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 06 September 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1,3-5,7-17,19-21,29,30,35-37,43 and 44.  
Claim(s) withdrawn from consideration: 22-28,32-34 and 39-42.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

**W. DAVID COLEMAN  
PRIMARY EXAMINER**

K.N.  
September 20<sup>th</sup>, 2005

Continuation of 11. does NOT place the application in condition for allowance because: Applicants contend that, the rejection admits, in multiple places, that Inomata does not explicitly disclose the limitation "M component is present in an amount effective for the film to exhibit a saturation magnetization of 35 to 80% relative to the saturation magnetization of a bulk metal body consisting exclusively of the M component". Applicants then concluded that the finality of the rejection is not proper because the Examiner admits that the newly cited reference fails to address the above-quoted limitation added by the previous amendment.

In response to Applicants' contention as described above, Examiner respectfully disagrees. Since Applicants' Amendment submitted on March 14th, 2005 raised new issues (i.e., "M component is present in an amount effective for the film to exhibit a saturation magnetization of 35 to 80% relative to the saturation magnetization of a bulk metal body consisting exclusively of the M component") necessitated a new ground of rejection. It is necessary for the Examiner to open the new ground of rejection because Applicants' original Claims does not required that the M component is present in an amount effective for the film to exhibit a saturation magnetization. Inomata disclosed this limitation in (col. 10, lines 50-63 and FIGS. 6, 32, and 34) and further discloses that magnetic loss film is a granular magnetic thin film, and is composed of M-X-Y, where M is at least Co, X is Al and Y is at least O (col. 2, lines 18-24). Since it is inherent that materials having a ferromagnetic component such as those disclosed by Inomata will exhibit a saturation magnetization percentage range relative to the saturation magnetization of a bulk metal body. The Examiner then relied on *In re Woodruff*, 919 F.2d 1575, 1578, 16 USPQ2d, 1934, 1936 (Fed. Cir. 1990) to address that there is no evidence indication the percentage range of the saturation magnetization exhibit relative to the saturation magnetization of a bulk metal body consisting exclusively of the M component is critical and it has been held that is not inventive to discover the optimum or workable percentage range of a result-effective variable within given prior art condition by routine experimentation.

For this reason, Examiner holds the rejection proper.